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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,857	09/01/1999	LUAN C. TRAN	MI22-878	4528

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EXAMINER

SCHILLINGER, LAURA M

ART UNIT PAPER NUMBER

2813

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/388,857

Applicant(s)

TRAN, LUAN C.

Examiner

Laura M Schillinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 51-84 is/are pending in the application.
- 4a) Of the above claim(s) 75-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 52,53,60-62 and 74 is/are allowed.
- 6) ☒ Claim(s) 1-7,51,54-59 and 63-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19-20.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to Amendment D filed 10/1/02 in Paper No. 18.

Election/Restrictions

Newly submitted claims 75-84 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 74-85 pertain to a distinct species from claims 1-7 and 51-74 because such claims require sloped walls.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 75-84 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7, 51, 67-73 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 8-20 of copending Application Nos. 09/834,660 and 10/071453. This is a provisional double patenting rejection since the conflicting claims have not

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in fact been patented. Claims 1-7, 51, 67-73 of this application conflict with claims 1-7, 8-20 of Application No. 09/834,660 and 10/071453 (which also both contain identical claims).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 54-59, 63-64, 65-66 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14, 6, 7 of copending Application Nos. 09/834,660 and 10/071453. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 9-14 requires two different active area widths, by having one with a width less than 1 micron with the other having a width greater than 1 micron. Claims 63-64 of this application conflict with claim 6 of applications 09/834660 and 10/071453 because claim 6 in dependent form incorporates all the limitations of its respective independent claim 1 and thereby includes all limitations recited in claims 63-64. Lastly, claims 65-66 of this application conflict with claim 7 of applications 09/834660 and 10/071453 because again claim 7 in its dependent form incorporates all the limitations of its respective independent claim 1 and thereby includes all limitations recited in claims 65-66.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822. Note the only non-conflicting claims pending are claims 52-53, 60-62 and 74.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: .
In reference to claims 60-62, Schuegraf ('976) teaches a method comprising:

forming a plurality of regions received within a substrate, the regions define active areas, with some widths being no greater than 1 um, at least two being different (Col.2, lines: 15-20));

forming a transistor gate line over the active areas , the transistor having different widths and voltages (Col.5, lines: 25-30).

However Schuegraf fails to teach that the T_V is less than 1 or 2 volts as claimed by the applicant. Schuegraf teaches that the threshold voltage is influenced by a number of factors including insulator thickness, dielectric constant, substrate doping, field implant dose, and substrate bias and trench parameters (Col.4, lines: 25-40). However, despite teaching that the threshold voltage is subject to variation, Schuegraf does not teach nor suggest limiting the threshold voltage, nor

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does Schuegraf teach limiting the voltage to 1 or 2 volts as applicant claims. Consequently, Applicant's claim language is allowable over prior art.

Further, in reference to claim 52, 53, and 74 Schuegraf fails to explicitly teach forming 3 transistors each having a different threshold voltage. Again, Schuegraf teaches that the threshold voltage is influenced by a number of factors including insulator thickness, dielectric constant, substrate doping, field implant dose, and substrate bias and trench parameters (Col.4, lines: 25-40). However fails to explicitly teach nor suggest forming 3 transistors each having a different corresponding threshold voltage. Consequently claims 52-53 and 74 also contain allowable subject matter.

Response to Arguments

Applicant's arguments with respect to claims 1-7 and 51-74 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura M Schillinger whose telephone number is (703) 308-6425. The examiner can normally be reached on M-T, R-F 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl W Whitehead, Jr. can be reached on (703) 308-4940. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1500.

LMS

December 29, 2002


CARL WHITEHEAD, JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800